

III. REMARKS

Claims 1-22 are pending in this application. By this Amendment, claims 1, 6, and 15 have been amended to correct grammatical errors and not for reasons relating to patentability. Reconsideration in view of the above amendments and following remarks is respectfully requested.

In the Office Action, claims 1, 5-16, and 20-22 are rejected under 35 U.S.C. § 103(a) over German Patent No. 21 13 358 to Joseph Vögele AG (the Vögele patent). This rejection is respectfully traversed. Applicants assert that the Office is misinterpreting the function of arm 2 of the Vögele device. The Vögele patent reads, "...smoothing bar 1, which, at this end, is attached to a not-shown road finishing machine via a pivotable outrigger arm 2." English translation of Vögele patent at 2. Thus, outrigger arm 2 serves to pivot smoothing bar 1 rather than sheet-metal guiding piece 3. As sheet-metal guiding piece 3 is fixedly attached to exterior surface 5 of smoothing bar 1, outrigger arm 2 may be viewed as indirectly serving to pivot sheet-metal guiding piece 3. However, for at least two reasons, such a view of the Vögele patent fails to make obvious the limitations of claims 1 and 15, from which all other rejected claims depend.

First, each of claims 1 and 15 recite "a coupling device for coupling the compaction member to the paving machine such that the compaction member is independently vertically movable against a bias during operation" (emphasis added). As the specification and figures of the application make clear, such independent vertical mobility of the compaction member is in reference to fixed structures of the paving machine, such as a fixed end gate or a screed.

Referring to FIGS. 7, 8A and 8B...Edge maker 352 includes a compaction member 376 including a compaction surface 380 for compacting paving material (not shown) received thereby, and a coupling device 382 for coupling compaction member 376 to a fixed structure of paving machine 150 (FIG. 3), i.e., not a vertically self-adjusting end gate...However, coupling device 382 includes a spring bias and a vertical adjustment

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system that allows for vertical movement of compaction member 376 so as to avoid the problems of the related art. ¶ 38.

In one embodiment, the fixed structure may be one of paving machine screed 358, a fixed end gate 170, screed extension 268 or a paving machine striker {not shown}. ¶ 40.

Hence, the vertical position of compaction surface 376 can be adjusted relative to the fixed structure of paving machine 150 (FIG. 3). In addition, a bias required to move compaction member 376 upwardly relative to mounting plate 410 can be adjusted by adjusting the position of bias adjustment member 426 along threaded rod 416. ¶ 41.

Thus, the devices of the present invention comprise a pavement ramp edge maker having a compaction surface capable of vertical movement independent of fixed structures of the paving machine. The Vögele patent, on the other hand, teaches a paving device having a fixed compaction member (3,6) that is incapable of vertical movement independent of smoothing bar 1.

Second, as noted above, each of claims 1 and 15 recite such independent vertical mobility of the compaction member during operation. That is, the devices of the present invention provide, *inter alia*, a pavement ramp edge maker having a compaction member capable of vertical movement independent of fixed structures of the edge maker during the paving process. Contrarily, as sheet-metal guiding piece 3 of the Vögele device is fixedly attached to exterior surface 5 of smoothing bar 1, it is necessarily incapable of vertical movement independent of the fixed structures of smoothing bar 1 during operation. In fact, Applicants assert that due to the fact that sheet-metal guiding piece 3 is fixedly attached to exterior surface 5, any pivoting of outrigger arm 2 during the paving process would necessarily pivot both smoothing bar 1 and sheet-metal guiding piece 3. Such pivoting during the paving process would completely frustrate the intended function of smoothing bar 1, which is to provide a flat, level paved surface. For the reasons above, Applicants respectfully request withdrawal of the rejection.

Regarding claim 7, the Office asserts that “the coupling device (2, 5) and the piece (not labeled) which extends outwardly from, and in the opposite direction to the compaction member (3), meet the recitation of a pair of support members.” Office Action at 3. While it is somewhat unclear which unlabeled piece the Office is referring to, Applicants assume that the Office is referring to the bottom, horizontally-oriented portion of external surface 5 to which anterior end 4 of sheet-metal guiding piece 3 terminates. Regardless of the functions served by the cited elements, it is clear from the Vögele figure that only the unlabeled piece contacts sheet-metal guiding piece 3. Thus, Applicants assert that the Vögele device neither teaches nor makes obvious “a pair of support members coupled to the compaction surface and the paving material directing member,” as recited in claim 7. Accordingly, Applicants respectfully request withdrawal of the rejection.

Regarding claims 8-12, the Office asserts that “the unlabeled piece has a rounded leading edge adapted to engage the surface.” Office Action at 3. First, Applicants note that only claim 8 recites such a limitation. Second, Applicants assert that the above arguments made with respect to claim 7 are equally applicable to claim 8, since claim 8 depends from claim 7. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office further asserts (presumably with respect only to claim 9) that the “[unlabeled] piece meets the recitations of a trailing directing member.” Office Action at 3. Applicants assert that to construe the unlabeled piece of the Vögele device as reading on claim 9 is to, *inter alia*, read the terms “trailing” and “directing” out of the claim. As is clear from FIG. 8A and the following quotation from paragraph 39 of the application, the trailing directing member must reside behind (with respect to a direction of travel) the directing member and be capable of directing paving material: “directing member 390 includes a trailing directing member 404

extending substantially in a direction of travel from a trailing edge 406 of paving material directing member 390.” Application at ¶ 39. Applicants assert that the unlabeled piece of the Vögelc device neither directs paving material nor trails a directing member and cannot, therefore, teach or make obvious the limitation of claim 9. Accordingly, Applicants request withdrawal of the rejection.

Next, regarding claims 12-14, the Office asserts that “the limitations regarding the edge angle are met by the portion (6) of the compaction member.” Office Action at 3. Applicants assert, however, that the above arguments made with respect to claim 1 are equally applicable to claims 12-14, since each directly or ultimately depends from claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office goes on to state (presumably with respect only to claim 14) that “[r]egarding the specific angle of 35 degrees, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used this angle in order to increase safety for users of the finished product, as is well known in the art.” Office Action at 3. Applicants respectfully assert that the Office has provided no evidence to support such a conclusion regarding the common knowledge in the art. *See* MPEP § 2144.03 (“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” Emphasis in original). Accordingly, Applicants assert that the Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). *See* MPEP §§ 706.02(j), 2142.

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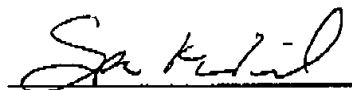
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In addition, Applicants assert that in making this rejection, the Office has read out of claim 14 the phrase "and the compaction angle." As Applicants cannot see how any element of the Vögele device could be construed as a compaction angle, as that phrase is used in the present invention, and as the Office has identified no such element in the Vögele device, Applicants assert that the Vögele device neither teaches nor makes obvious the use of a compaction angle and respectfully request withdrawal of the rejection.

Finally the Office states that "[r]egarding claims 15, 16 and 20-22, there is an end gate (5) and a screed (not labeled)." Office Action at 3. However, for each of the reasons given above with respect to the independently vertically movable compaction member, the trailing directing member, and the trailing compaction surface, Applicants assert that the Vögele patent neither teaches nor makes obvious the limitations of these claims. Accordingly, for each of these reasons, Applicants respectfully request withdrawal of the rejection.

In view of the foregoing and for each of the reasons given above, Applicants respectfully request withdrawal of the rejection and allowance of the application. Should the Examiner require anything further from Applicants, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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